

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)
Fertner et al.)
Serial No.: 10/537,882) Group Art Unit: 3761
Filed: June 07, 2005) Examiner: Jacqueline F. Stephens
For: PERSONAL CARE APPARATUS) **Board of Patent Appeals and**
WITH A SUCTION PIPETTE) **Interferences**
Confirmation No.: 8419)

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REPLY BRIEF UNDER 37 C.F.R. § 41.41

In response to the Examiner's Answer mailed on January 23, 2009, to the Appeal Brief filed September 15, 2008, and pursuant to 37 C.F.R. § 41.41, Appellants present this Reply Brief in the above-captioned application.

This is an appeal to the Board of Patent Appeals and Interferences from the Examiner's final rejection of claims 1-14 in the Final Office Action dated October 2, 2007 as affirmed in the Advisory Action dated January 10, 2008. The appealed claims are set forth in the attached Claims Appendix.

1. Status of the Claims

Claims 1-14 have been rejected in the Final Office Action. The final rejection of claims 1-14 is being appealed.

2. Grounds of Rejection to be Reviewed on Appeal

I. Whether claims 1-14 are unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 1,488,376 to Bryant (hereinafter "Bryant").

3. Argument

I. The Rejection of Claims 1-14 Under 35 U.S.C. § 103(a) Over Bryant Should Be Reversed.

A. The Examiner's Rejection

In the Final Office Action, the Examiner rejected claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over Bryant. (See 10/2/07 Office Action, p. 2.)

Bryant is directed to a suction apparatus to extract snake poison from human skin. The apparatus of Bryant consists of a cylindrical body (10) and a vacuum chamber (18). The body has a flared mouth (11) to form an airtight seal with skin to extract the snake venom. (See Bryant p. 1, ll. 36-42.) A manual pump (10) uses a stem (14) and a ring (15) to create suction by the manual pulling out and pushing in of the stem (14). (See Bryant p. 1, ll. 63-71.)

B. Bryant Does Not Disclose Wherein The Suction Piece Has At Least Two Suction Piece Sections Extending To The Suction Aperture And Defining The Suction Aperture, Said Two Suction Piece Sections Being Radially Adjustable, As Recited In Claim 1

Claim 1 recites, "wherein the suction piece has at least two suction piece sections extending to the suction aperture and defining the suction aperture, said two suction piece sections being radially adjustable." In the Final Office Action dated October 2, 2007, the Examiner failed to address the above limitation when rejecting claim 1. In the Advisory Action

dated January 10, 2008, the Examiner stated that, “these limitations are directed to an intended use of the article. Intended use must result in a structural difference between the claimed invention and the prior art.” (See 1/10/08 Advisory Action p. 1.) Appellants respectfully disagree.

Claim 1 specifically recites that the suction piece (8) has two suction piece sections (14) and (15) that extend to form an aperture (13). Claim 1 further recites that each of the suction piece sections (14) and (15) is radially adjustable. Thus, through the radial adjustment of the suction piece sections (14) and (15), the size of the aperture (13) can be changed. This is a fundamental difference between claim 1 and the apparatus of Bryant. Bryant teaches a flared mouth (11) made out of either rubber or metal. The flared mouth, however, is of a fixed aperture. The fixed aperture limits the force of the suction applied to the skin since the force of suction is dependant on the size of the aperture. In contrast, claim 1 specifically states, “two suction piece sections being radially adjustable.”

With respect to the Examiner’s contention that this recitation is directed to an intended use and not a structural difference, the Appellants respectfully disagree. The recitation of “two suction piece sections being radially adjustable” is clearly a structural limitation of the claim. While it is intended that a user will make use of this feature to alter the size of the aperture, the apparatus itself includes two suction piece sections that are radially adjustable. That is, the two suction piece sections are designed to be radially adjustable within the overall apparatus. This is fully described and enabled in the specification. (See, Specification, p. 7, ll. 1-6; Fig. 1.) Accordingly, the recitation of “two suction piece sections being radially adjustable” is a structural limitation of claim 1.

The Examiner’s Answer asserts that the suction piece of Bryant has upper and lower sections, and that such upper and lower sections provide the “two suction piece sections” recited by claim 1. (See 1/23/09 Answer, p. 5.) The Answer further asserts that claim 1 does not require that the two pieces be radially adjustable to one another, merely that they be radially adjustable. (See id., pp. 5-6.) Thus, the Examiner asserts that the threaded lines of the body portion (18) provide a suction piece that is radially adjustable. (See id., p. 6.)

The Appellants are uncertain as to what two sections of the apparatus of Bryant the Examiner intends to characterize as upper and lower sections. The tubular member (10) is disposed above the vacuum chamber (18) and adjoining mouth piece (11) in the illustrations of

Figures 1-3 of Bryant. (See Bryant, Figs. 1-3.) However, only the mouth piece (11) contacts the surface of the body of the victim. (See id., p. 1, ll. 36-49.) The tubular member (10) is merely a vessel in which vacuum pressure is generated and conveyed to the vacuum chamber (18) via the lateral member (10a). (See id., p. 1, ll. 56-66.) Thus, Bryant fails to disclose or suggest “at least two suction piece sections *extending to the suction aperture and defining the suction aperture,*” as recited in claim 1.

The Appellants further note that Bryant neither discloses nor suggests that the threading of the body portion (18) provides for any adjustability of the suction piece, radially or otherwise. (See Bryant, p. 1, ll. 50-55.) Rather, the Appellants respectfully submit that the threading merely provides the means by which the mouth piece (11) is engaged with the body portion (18). (See id., p. 1, ll. 50-55.) Thus, Bryant fails to disclose or suggest “at least two suction piece sections extending to the suction aperture and defining the suction aperture, *said two suction piece sections being radially adjustable.*” Further, even if it were to be assumed, for the sake of argument, that the mouth piece (11) is radially adjustable, the Appellants nonetheless submit that Bryant does not disclose or suggest *two* radially adjustable suction pieces, as recited in claim 1.

Accordingly, the recitation of two radially adjustable suction pieces renders Bryant ineffective. Therefore, Appellants respectfully submit that claim 1 is patentable over Bryant and request the Board overturn the rejection of claim 1. Because claims 2-7 depend from and, therefore, include all the limitations of claim 1, it is respectfully submitted that these claims are also allowable for at least the same reasons stated above with respect to claim 1.

Independent claim 8 recites, “at least two suction piece sections extending to the suction aperture and defining the suction aperture, *said two suction piece sections being radially adjustable.*” Appellants respectfully submit that this claim is allowable for at least the same reasons stated above with respect to claim 1, and that the Board should therefore overturn the Examiner’s rejection of this claim. Because claims 9-14 depend from and, therefore, include all the limitations of claim 8, it is respectfully submitted that these claims are also allowable for at least the same reasons given above with respect to claim 8.

4. Conclusion

For the reasons set forth above, Appellants respectfully request that the Board reverse the rejection of the claims by the Examiner under 35 U.S.C. § 103(a), and indicate that claims 1-14 are allowable.

Respectfully submitted,

Date: March 17, 2009
By: 
Michael Marcin (Reg. No. 48,198)

Fay Kaplun & Marcin, LLP
150 Broadway, Suite 702
New York, NY 10038
Tel: (212) 619-6000
Fax: (212) 619-0276

CLAIMS APPENDIX

1. (Previously Presented) A personal care apparatus comprising an air pump having a suction piece and a motor for exerting a suction effect on the human skin, wherein the suction piece is connected to the air pump via an air-transfer duct, and wherein the suction piece has at least one circumferentially defined suction aperture for suction-based interaction with the human skin, and wherein the suction piece in the area of the suction aperture is designed to form a skin protuberance in a suction-based interaction with the skin, and wherein the suction piece has at least two suction piece sections extending to the suction aperture and defining the suction aperture, said two suction piece sections being radially adjustable and designed to exert a radial force on a skin protuberance formed in a suction-based interaction with the skin, and wherein the suction piece has at least two sealing parts of elastically deformable design extending to the suction aperture and defining the suction aperture, each sealing part being situated between two mutually adjacent suction piece sections and having an airtight connection to the two mutually adjacent suction piece sections.
2. (Original) A personal care apparatus (1) as claimed in claim 1, wherein the suction piece (8) has two diametrically opposed suction piece sections (14, 15), which are composed of a material that is relatively hard compared to the elastically deformable sealing parts (19, 20).
3. (Original) A personal care apparatus (1) as claimed in claim 2, wherein the suction piece (8) with its two suction piece sections (14, 15) and its two sealing parts (19, 20) has been manufactured by a two-component injection molding process.
4. (Original) A personal care apparatus (1) as claimed in claim 2, wherein the at least two suction piece sections (14, 15) of the suction piece (8) each have a sharp defining edge (K) for defining the suction aperture (13).
5. (Original) A personal care apparatus (1) as claimed in claim 4, wherein the at least two defining edges (K) have a circular arc shape.

6. (Original) A personal care apparatus (1) as claimed in claim 5, wherein the at least two defining edges (K) have a diametric interval of between 3.0 mm and 4.0 mm.
7. (Original) A personal care apparatus (1) as claimed in claim 6, wherein the at least two defining edges (K) have a diametric interval of 3.4 mm.
8. (Previously Presented) A suction piece for a personal care apparatus, comprising:
 - at least one circumferentially defined suction aperture for suction-based interaction with the human skin, wherein the suction piece in the area of the suction aperture is designed to form a skin protuberance in a suction-based interaction with the skin;
 - at least two suction piece sections extending to the suction aperture and defining the suction aperture, said two suction piece sections being radially adjustable and designed to exert a radial force on a skin protuberance formed in a suction-based interaction with the skin;
 - at least two sealing parts of elastically deformable design extending to the suction aperture and defining the suction aperture, each sealing part being situated between two mutually adjacent suction piece sections and having an airtight connection to the two mutually adjacent suction piece sections .
9. (Original) A suction piece (8) as claimed in claim 8, wherein the suction piece (8) has two diametrically opposed suction piece sections (14, 15) which are composed of a relatively hard material compared to the elastically deformable sealing parts (19, 20).
10. (Original) A suction piece (8) as claimed in claim 9, wherein the suction piece (8) with its two suction piece sections (14, 15) and its two sealing parts (19, 20) has been manufactured by a two-component injection molding process.
11. (Original) A suction piece (8) as claimed in claim 8, wherein the at least two suction piece sections (14, 15) of the suction pieces (8) each have a sharp defining edge (K) for defining the suction aperture (13).

12. (Original) A suction piece (8) as claimed in claim 11, wherein the at least two defining edges (K) have a circular arc shape.

13. (Original) A suction piece (8) as claimed in claim 12, wherein the at least two defining edges (K) have a diametric interval of between 3.0 mm and 4.0 mm.

14. (Original) A suction piece (8) as claimed in claim 13, wherein the at least two defining edges (K) have a diametric interval of 3.4 mm.